

DOCKET NO. 248810US2CONT



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF:

GEOFFREY A. SCARSBROOK ET AL. :EXAMINER: MONDT, JOHANNES P.

SERIAL NO: 10/777,633 :

FILED: FEBRUARY 13, 2004 :GROUP ART UNIT: 2826

FOR: SINGLE CRYSTAL DIAMOND PREPARED BY CVD

RESTRICTION RESPONSE

COMMISSIONER FOR PATENTS
ALEXANDRIA, VA 22313

SIR:

In response to the Restriction Requirement dated September 8, 2005, Applicants provisionally elect with traverse Group I corresponding to Claims 1-13 and 31-34.

Applicants make this election based on the understanding that Applicants are not prejudiced against filing one or more divisional applications that cover the non-elected claims.

Concerning the election species requested in the Restriction Requirement, Applicants provisionally elect species five as readable on Claims 11, 12, 13, and 31-34.

Concerning these elections, Applicants respectfully traverse the Restriction Requirement and the Election of Species Requirement on the grounds that the present application is a continuation of a 371 of PCT/IB01/01037 and as such is subject to the unity of invention and not restriction practice. MPEP § 1893.03(d) states that examiners are reminded that unity of invention (not restriction practice) is applicable in international applications and in national stage applications submitted under 35 U.S.C. § 371.

Further, as noted in MPEP § 1893.03(d):

When making a lack of unity of invention requirement, the examiner must (1) list the different groups of claims and (2) explain why each group lacks unity with each other group (i.e., why there is no single general inventive concept) specifically describing the unique special technical feature in each group.

No such explanation of why each group lacks unity with each other group has been made.

Rather, only specified features of different groups of claims have been listed.

Furthermore, the identification in the Restriction Requirement of Claim 1 as a generic claim would seem to preclude, under the unity of invention standard, the division of the claims into separate groups. Accordingly, Applicants respectfully request that the present Restriction and Election of Species Requirement be withdrawn and that a full examination on the merits of Claims 1-34 be conducted.

Respectfully submitted,

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